

REMARKS

The Applicant has carefully read and reviewed the Office Action dated May 28, 1996. In response thereto, claims 1, 2, and 12 have been canceled and claims 3-11 have been amended. Claims 3-11 are pending in the application.

Claims 1, 2 and 9 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as invention. As a result of the cancellation of claims 1 and 2 as well as the amendments to claim 9 which add the term "adapted", this rejection under 35 U.S.C. § 112, second paragraph has been overcome.

Claim 9 was rejected under 35 U.S.C. § 102(b) as being anticipated by Hess et al. As amended, claim 9 has been made dependent on claim 3 and many of the limitations of the former claim language in claim 9 has been moved to claim 3. Hess et al. teaches an electrode array formed by electrodes extending radially outward in a disk shape. In contrast, the present invention, as claimed in claim 3 from which claim 9 depends, is directed to the formation of an electrode array which defines a substantially spherical shaped space. Thus, Hess et al fails to teach the present invention as claimed. Therefore, the rejection of claim 9 under 35 U.S.C. §102(b) should be withdrawn.

Claim 9 was rejected under 35 U.S.C. § 103 as being unpatentable over Taccardi in view of Watanabe. As previously noted much of the limitations formerly found in claim 9 have been moved to claim 3 from which claim 9 now depends. The following discussion will be directed to both present claim 3 and 9.

None of these references alone or in combination contains the "objective teaching" or in anyway suggests a combination of references adequate to render the claimed invention obvious. In particular, none of the cited references teach a mapping catheter which uses both electrodes touching and spaced apart from an

interior of a patient's heart. Taccardi teaches the use of electrodes spaced apart from the heart surface and Watanabe teaches the use of electrodes which touch the heart surface. Neither reference suggests the use of both type of electrodes on a single catheter. But for the hindsight gained from the teachings of the present invention, a combination of these two references to form the present invention of uses both types of electrodes would not have been done. Therefore, the rejection of claim 9 under 35 U.S.C. § 103 as being unpatentable over the cited prior art should be withdrawn.

Claims 1-12 were rejected under an obviousness-type double patenting rejection based on U.S. Patent No. 5,297,549 and 5,311,866. These two patents are assigned to the same assignee as the present invention. If subject matter in the present invention claims are otherwise found to be allowable, then a terminal disclaimer will be provided by the applicant to overcome this rejection.

The Applicant has read and reviewed the other references cited by the Examiner and determined that they do not teach the present invention as claimed.

In summary, the claims have been modified to particularly point out and distinctly claim the subject matter which the Applicant regards as his invention. In addition, the present invention is not taught by the prior art of record or any combination thereof. Therefore, it is respectfully submitted that the pending claims are in condition for allowance, and a favorable action with respect to the present application is respectfully requested.

Respectfully submitted,

Graydon Ernest Beatty et al.

By his agent

MERCHANT, GOULD, SMITH, EDELL,
WELTER & SCHMIDT, P.A.
3100 Norwest Center
90 South Seventh Street
Minneapolis, Minnesota 55402
(612) 336-4708

By



Shawn B. Dempster
Reg. No. 34,321

SBD/RCB/tmj